

Atty. Dkt. No. 051373-0126

REMARKS

This reply is in response to the office action mailed on February 27, 2006 in which claims 1, 3-37 and 40-45 were rejected. With this response, claims 7-11, 15, 26-28 and 31-33 are canceled; and claims 46-60 are added. Claims 1, 3-6, 12-14, 16-20, 22-25, 29-30, 34-37, and 40-60 are presented for reconsideration and allowance.

I. Rejection of Claims 1, 3-20, 22-37 and 40-45 under 35 USC 103(a) Based upon Markowitz and Bauer

Page 2 of the Office Action rejected claims 1, 3-20, 22-37 and 40-45 under 35 USC 103(a) as being unpalatable over Markowitz US Patent 6,295,346 in view of Bauer et al. US Patent 6,751,603. Claims 7-11, 15, 26-28 and 31-33 are canceled. For the reasons which follow, the rejection of claims should be withdrawn.

A. Claims 1, 20, and 37

Claim 1 is directed to a method of producing custom output in response to user input and recites, among other limitations:

- a) receiving an input code from the wireless Internet-enabled device via a web interface of a server computer, the input code associated with one of the plurality of user entry buttons and representing user input provided at the wireless Internet-enabled device by activation of the user entry button;
- b) locating in a programmable device at least one user-specified output character associated with the user entry button, in response to receipt of the input code, the programmable device storing a plurality of user-specified output characters associated with the plurality of user entry buttons;

Claim 20 is directed to an apparatus for producing custom output in response to user input and recites, among other limitations:

- a) a receiving interface operable to receive an input code . . . the input code associated with one of the plurality of user entry buttons and representing user input provided at the wireless Internet-enabled device by activation of the user entry button;

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- b) a programmable device . . . storing at least one user-specified output character associated with the user entry button; and
- c) a processor circuit . . . operable to locate in said programmable device at least one user-specified output character associated with the user entry button . . .

Claim 37 is directed to an apparatus for producing custom output in response to user input and recites, among other limitations:

- a) means for receiving an input code . . . the input code associated with one of the plurality of user entry buttons and representing user input provided at the wireless Internet-enabled device by activation of the user entry button;
- b) means for storing at least one user-specified output character associated with the user entry button;
- c) means for locating . . . at least one user-specified output character associated with the user entry button, in response to receipt of the input code representing said user entry button;

As discussed in the specification, a wireless device 50 accesses a server 18 via a communication network 30, such as the Internet. See, Figure 1, Specification, page 6, lines 4-14. The server 18 includes a web interface to permit input codes associated with user entry buttons of the wireless device to be received from the wireless device 50 via the Internet 30. See, Figures 1 and 2, Specification, page 3, lines 6-12, page 7, line 25 to page 8, line 4, page 9, lines 7-11 and page 10, lines 20-21. Each user entry button on the wireless device 50 may be associated with user-specified output characters stored in a programmable device 12 of server 18. See, Figures 4 and 5, Specification, page 3, lines 6-12, page 6, lines 22-27, page 8, lines 18-21 and page 9, lines 19-23. When a user entry button is activated on the wireless device, a user-specified output character(s) previously associated with the user entry button is provided. See, Specification, page 11, line 28 to page 12, line 1. Accordingly, the system allows a users to specify their own custom output for user entry buttons on the wireless device and provide a degree of customization to the use of the Internet-enabled wireless device. See, Specification, page 2, lines 6-9, page 3, lines 12-15, page 6, lines 18-29 and page 9, lines 19-23.

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Neither Markowitz nor Bauer, alone or in combination, teach, suggest or disclose, associating at least one user-specified output character with a user entry button on a wireless Internet-enabled device, storing a plurality of user-specified output characters associated with the plurality of user entry buttons or locating at least one user-specified output character associated with a user entry button. In contrast, Markowitz merely discloses an emergency notification system for a phone, wherein notifications are automatically sent to selected parties by the phone system (Local Exchange Carrier (LEC) switches) when a person dials the phone number of an emergency service provider. Markowitz does not disclose receiving an input code from a wireless Internet enabled device via a web interface of a server computer.

Page 3 of the Office Action acknowledges that Markowitz fails to disclose receiving an input code from a wireless Internet-enabled device via a web interface of a server computer. As a result, the Office Action attempts to additionally rely upon Bauer for this feature. However, in contrast to assertion made in the Office Action, it would not be obvious to modify Markowitz based on Bauer.

In an attempt to establish a prima facie case of obviousness, the Office Action asserts that:

it would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Bauer to the method of Markowitz to use the artless Internet enabled device via a web interface of a server computer because by using the wireless device to input the code through the interface of the server computer would accelerate and facilitate the process of finding datafile in a computer system (see Bauer col.1, lines 8-21).

(Office Action, page 3). However, this alleged motivation for modifying Markowitz based on Bauer lacks merit. Markowitz has **nothing** to do with finding a data file in a computer system. Nowhere does Markowitz indicate that it even relates to "the process of finding data file in a computer system". Since Markowitz has nothing to do with finding a data file in a computer system, one of ordinary skill in the art would have no reason to modify Markowitz for this reason.

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Moreover, since the explicit purpose of Markowitz is to facilitate the notification of parties when a phone call is placed to an emergency service provider, it would make little sense to somehow replace the phone and local exchange carrier (LEC) switches disclosed by Markowitz with a wireless Internet-enabled device communicating via a web interface every server computer. Persons contacting an emergency service provider, such as a fire department, a police station and the like, would not normally use a web interface. Thus, the rejection based on the combination of Markowitz and Bauer should be withdrawn.

Claims 3-6, 12-14, 16-19 and 44 depend from claim 1 and incorporate all of the limitations of amended claim 1 and are therefore allowable over Markowitz in view of Bauer for, among other reasons, the same reasons as given above with respect to amended claim 1. Claims 22-25, 29-30, 34-36 and 45 depend from claim 20 and incorporate all of the limitations of amended claim 20 and are therefore allowable over Markowitz in view of Bauer for, among other reasons, the same reasons as given above with respect to amended claim 20.

B. Claims 40 and 41

Independent claim 40 is directed to an apparatus for producing user-specified output characters in response to input codes and recites, among other limitations a web server programmed to produce at least one user-specified output character associated with one of the plurality of user entry buttons in response to receipt of an input code associated with the user entry button.

Independent claim 41 is directed to an e-mail system and recites, among other limitations:

a) a web server operable to establish communications with web-communicating input devices using the World Wide Web, each web-communicating input device having a plurality of user entry buttons; . . .

c) at least one of said web server and said e-mail server being programmed to produce at least one user-specified output character associated with one of the plurality of user entry buttons of one of the web-communicating input devices . . . in

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response to receipt of a input code associated with the user entry button. . .

As discussed in the specification, a wireless device 50 accesses a server 18 via a communication network 30, such as the Internet. See, Figure 1, Specification, page 6, lines 4-14. Each user entry button on the wireless device 50 may be associated with user-specified output characters. See, Figures 4 and 5, Specification, page 3, lines 6-12, page 6, lines 22-27, page 8, lines 18-21 and page 9, lines 19-23. When a user entry button is pressed on the wireless device, a user-specified output character(s) previously associated with the user entry button is provided. See, Specification, page 11, line 28 to page 12, line 1. Accordingly, the system allows a users to specify their own custom output for user entry buttons on the wireless device and provide a degree of customization to the use of the Internet-enabled wireless device. See, Specification, page 2, lines 6-9, page 3, lines 12-15, page 6, lines 18-29 and page 9, lines 19-23.

Neither Markowitz nor Bauer, alone or in combination, disclose or suggest a web communicating input device for entry of input codes using user entry buttons and the transmission of such input codes using the World Wide Web to produce at least one user-specified output character in a field of an e-mail. As noted above, the Office Action acknowledges that Markowitz fails to disclose the use of a wireless Internet-enabled device or a web interface of a server computer. As a result, the Office Action attempts to additionally rely upon Bauer to satisfy this acknowledged efficiency of Markowitz.

However, as noted above, motivation alleged by the Office Action for modifying Markowitz based on Bauer is devoid of merit. Since Markowitz has nothing to do with locating a datafile on a computer, one of ordinary skill in the art would not be led to modify Markowitz based on Bauer for this reason. Moreover, as also noted above, since the explicit purpose of Markowitz is to notify parties in response to a call being made to an emergency service provider, it would not be obvious to somehow replace the phone and local exchange carrier (LEC) switches disclosed by Markowitz with a wireless Internet-enabled device communicating via a web interface every server computer. Persons contacting an emergency service provider, such as a fire department, a police station and the like, would not normally use a web interface. Thus, the rejection of claims 40 and 41 should be withdrawn.

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Claims 42 and 43 depend from claim 41 and incorporate all of the limitations of amended claim 41 and are therefore allowable over Markowitz in view of Bauer for, among other reasons, the same reasons as given above with respect to claim 41.

II. Added Claims

With this response, claims 46-60 are added. Claims 46-60 are believed to be patentably distinct over the prior art of record and are presented for consideration and allowance.

A. Claims 46, 51 and 56

Claim 46 depends from claim 1 and recites that the application program provides a users a prompt for text input at the wireless internet-enabled device, wherein the input code is received as a response to the prompt at the wireless internet-enabled device. Claim 46 further recites that the response is transmitted to the application program after the at least one user-specified output character is substituted in place of the received input code for the response.

Claim 51 depends from Claim 20 and recites that an application program provides a user with a prompt for text input at the wireless internet-enabled device and that the input code is received as a response to the prompt at the wireless Internet enabled device. Claim 51 further recites that the processor circuit is configured to transmit the response to the application program after the processor circuit substitutes the least one users-specified output character in place of the received input code for the response.

Claim 56 depends from claim 41 and recites that the e-mail server provides a user with a prompt for text input at the web communicating device, wherein the input code is received as a response to the prompt at the web communicating device. Claim 56 further recites that the web server is configured to transmit the response to the e-mail server after the web server substitutes the at least one user-specified output character in place of the received input code for the response. Support for added claims 46, 51 and 56 may be found in at least page 11, line 28-page 12, line 5. Thus, no new matter is believed to be added.

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In short, each of added claims 46, 51 and 56 recites that the input code is entered as a response to a prompt provided by an application program or e-mail server. Each of such claims further recites that the at least one user-specified output character is substituted in place of the received input code prior to the response being transmitted back to the application program.

The prior art of record fails to disclose transmitting a response back to an application program, wherein at least one user-specified output character is substituted in place of the entered input code. For example, Markowitz does not disclose substituting a user-specified output character in place of an input code entered as a response to a prompt before the response is returned to the application program. With Markowitz, the entry of a phone number of an emergency service provider simply triggers additional notifications. In Markowitz, when a person enters a the phone number of an emergency service provider, that phone number is not discarded and replaced with a user-specified output character. Rather, the phone number of the emergency service provider that is entered is used by the local exchange carrier to connect to the emergency service provider. Thus, added claims 46, 51 of 56 are believed to be patentably distinct over the part of record, including Markowitz and Bauer.

B. Claims 47, 52 and 57

Claims 47, 52 and 57 depend from claims 46, 51 and 56, respectively. Each of such claims recites that the response is displayed by the application program or the e-mail server on the wireless Internet-enabled device or the web-communicating input device with the substituted at least one user-specified output character.

Support for added claims 47, 52 and 57 may be found in at least page 11, line 20-page 12, line 5. In particular, the specification describes an e-mail application program presented on a wireless device 50 which prompts the user for a text input to be placed in the body of an e-mail. As one of ordinary skill in the arts knows, such prompts of an e-mail system on a wireless device 50 are displayed on a screen. As one of order and skill in the art also knows, when a response to a prompt is entered, the application program, the e-mail program, causes

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the response received by the e-mail program to also be displayed after the prompt on the wireless device. Therefore, the response, the substituted output character would also be presented after the prompt on the screen by the e-mail application program. Thus, no new matter is believed to be added.

The prior art to record fails to disclose displaying a substituted user-specified output character on the wireless internet-enabled device or the Web-communicating input device. For example, Markowitz does not disclose that the notification message is ever presented on the phone in which the emergency provider phone number is entered. Moreover, since a notification message is not substituted in place of the emergency provider phone number, such display of the notification message would not be inherent. Thus, claims 47, 52 and 57 are presented for consideration and allowance.

C. Claims 48, 49, 53, 54 and 58, 59

Claims 48, 53 and 58 depend from claims 47, 52 and 57, respectively. Claims 49, 54 and 59 depend from Claims 1, 20 and 41, respectively. Each of such claims recites that the input code excludes a phone number. Support for such added claims maybe found in at least Figure 5 which illustrates input codes "00" and " 01" which are clearly not phone numbers. Thus, no new matter is believed to be added.

The prior art of record fails to disclose input codes other than phone numbers. In fact, since the whole point of Markowitz is to notify other parties when any phoned number of an emergency service provider is entered, it would not be obvious to use anything other than a phone number. Accordingly, claims 48, 49, 53, 54, 58 and 59 are presented for consideration and allowance.

D. Claims 50, 55 and 60

Claim 50, 55 and 60 depend from claims 1, 20 and 41, respectively. Each of such claims recites that the input code is not transmitted to the application program. Support for such claims may be found in at least page 11, line 28-page 12, line 5 which recites that the

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output characters are substituted for the input code before being transmitted to the application program. Thus, no new matter is believed to be added.

The prior art of record fails to disclose the method, the apparatus or the e-mail system of claims 1, 20 and 41, wherein the input code is not transmitted to the application program. For example, Markowitz specifically requires that the entered emergency phone number be forwarded to the local exchange carrier to make a connection to the emergency service provider. To not forward the entered the emergency phone number to the logical exchange carrier in such an emergency would completely contradict the purpose of Markowitz and would potentially result in a tragedy. Thus, claims 50, 55 and 60 are presented for consideration and allowance.

II. Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-3815. Should no proper payment be enclosed herewith, as by a credit card authorization being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-3815

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Respectfully submitted,

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